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OFFICE OF PETITIONS

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

In re Application of :
Gordon G. Guay :
Application No. 10/664,818 : DECISION ON PETITION
Filed: September 16, 2003 :
Attorney Docket No. 08935-298001 / M-5032 :

This is a decision on the petition filed February 18, 2010, under the provisions of 37 CFR 1.59(b), to expunge information from the above identified application.

The petition to expunge is **DISMISSED**.

Any request for reconsideration of this decision must include a cover letter entitled "Renewed Petition under 37 CFR 1.59(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Petitioner is seeking to have expunged a Notice of appeal filed on February 18, 2010, from the file record of the instant application, stating that "[the] document was inadvertently filed in the wrong application."

The grant of a petition under 37 CFR 1.59 (b) to expunge information submitted in an incorrect application will be governed by the factors: (A) the Office can effect such return prior to the issuance of any patent on the application in issue; (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted; (C) the information has not otherwise been made public; (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted; (E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and (F) the petition fee as set forth in 37 CFR 1.17(g) is included. See MPEP 724.05 (III). The instant petition fails to satisfy the factors (B), (D) and (E).

In regard to factors (B) and (D), the instant petition fails to include a statement that states (a) failure to obtain the return of the information submitted would cause irreparable harm to the

party who submitted the information or to the party in interest on whose behalf the information was submitted, and (b) that there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted.

In regard to item (E), petitioner should note that the petition is premature since prosecution of the application has not been closed by way of the allowance of the application, the mailing of an Ex parte Quayle action, or the abandonment of the application. See MPEP 724.06. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material and the conditions related to the expungement of unintentionally submitted information, discussed as A-F above, are satisfied, the information will be removed from the official file.

Any request for reconsideration of this decision must include a cover letter entitled "Renewed Petition under 37 CFR 1.59(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704. After the mailing of a Notice of Allowance, an Ex parte Quayle action or a Notice of Abandonment, the petition to expunge may be renewed by applicant(s) or applicant(s)' representative. No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. **In addition, the requester is cautioned to renew the petition under 37 CFR 1.59 for reconsideration by the Office prior to the point at which the present file, or file claiming priority to the present file, is forwarded for issuance of the patent. This is to be done no later than immediately after the examiner has issued a Notice of Allowance, an Ex parte Quayle action or a Notice of Abandonment. A failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance will result in the material being retained in the patented file and thus becoming open to the public.**

The fee required for consideration of the instant petition is \$200. Petitioner has paid \$130. The balance of \$70 has been charged to the Deposit Account 06-1050, as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
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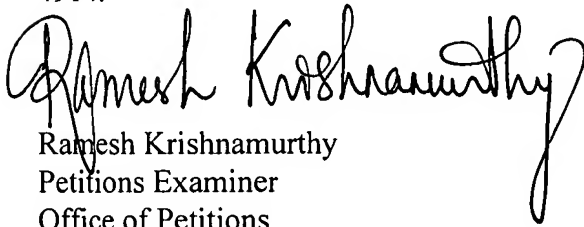
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The centralized facsimile number is **(571) 273-8300**.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4914.

A handwritten signature in black ink, reading "Ramesh Krishnamurthy". The signature is fluid and cursive, with the first name "Ramesh" and last name "Krishnamurthy" clearly legible.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

CC: Denis G. Maloney
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